

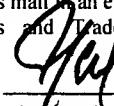


GP 2731

#24

Docket No. 2731-SP/54265.USC/GPTU13/APC/jgf

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:
September 5, 2000
(date) 
Alan Israel
Reg. No. 27,564

RECEIVED
SEP 15 2000
TC 2700 MAIL ROOM

In re: Application of : Mark T. JEFFREY, et al.
Serial No. : 08/872,078 Group Art Unit: 2731
Filed : June 10, 1997 Examiner: W. Luther
For : STM SWITCHING ARRANGEMENT

New York, New York
September 5, 2000

COMMUNICATION

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Prior to examination, consideration and entry of the following remarks are requested.

Regarding the Examiner's rejection under 35 U.S.C. §103 in the parent application, the Examiner relies on the combination of Takeuchi and Beshai. However, it is not apparent how such a combination could result in an arrangement which offered the attributes claimed by the Examiner. In the opinion of the applicants, such a combination would not be practical and *would not work*.

Turning to Beshai, the central element of the switch (18) comprises a set of packet buffers. These are connected to inputs and outputs via sets of input and output FIFO's (14, 16). Distribution of incoming packets among the various packet buffers is achieved by means of the input rotator. In introducing the concept of the rotator, Beshai states (col. 4, lines 3-7) that, due to the nature of the operation of the switch, both the outlet and the input "must rotate".

In contrast, in the system of Takeuchi, distribution of incoming packets is achieved by means of the bus 215. It is evident that rotators are *not necessary* for correct operation of the arrangement of Takeuchi.

The applicants would like to point out that these two methods of distribution -- rotator and bus -- are mutually incompatible and inclusion of both types of distribution in one system is contrary to common sense. If, for instance, it is proposed to include a rotator from Beshai at the input to the unit switches of Takeuchi (#1 - # P) any distribution thereby achieved would be changed by redistribution via the bus. If, as in Beshai, the rotator is able to achieve the desired distribution, then the bus of Takeuchi would appear to be redundant.

Following this line further: the rotator in Beshai would require addition of FIFO buffers at the inputs. If rotators were to be added to the outputs, then a similar argument applies and further FIFO buffers should be added here as well. In the resulting system therefore, the bus 215 and the FIFO buffers 2171 of the unit switches of Takeuchi would no longer be necessary. However, removing these features would arrive at a system substantially identical to that disclosed by Beshai, as distinct from any proposed combination of Beshai with Takeuchi. In fact, the characteristic features of Takeuchi are no longer present.

The applicants therefore respectfully disagree with the Examiner when he states that it would have been obvious to one of ordinary skill to adapt the ATM switch of Takeuchi in the light of Beshai. As shown above, such a combination is not practical.

Applicants also point out that, contrary to the statement by the Examiner, no suggestion can be found in Beshai to adapt the ATM switch of Takeuchi to STM switching.

Applicants respectfully maintain their argument, originally put forward in the Preliminary Amendment of March 6, 1995, that it is not possible to include rotators in Takeuchi by any simple means and any such suggestion by the Examiner has no foundation. Even if it were possible to include rotators in Takeuchi, this would *not* convert into an STM switch. There is *no* indication of how to carry out such a conversion. Indeed, this conversion does not appear possible.

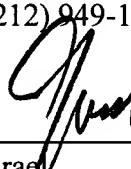
The Examiner suggests that the ATM switch of Takeuchi can be converted into an STM switch on the basis of a reference to a hybrid STM/ATM switch in Beshai and that the rotor of Beshai can be added to the converted switch of Takeuchi, whereas there is no teaching in either Takeuchi or Beshai that the above can or should be carried out. Applicants restate their opinion that the Examiner appears to be attempting to conclude that the cited references anticipate or make obvious the combination of elements of the claims by the use of hindsight. The Examiner employs a quotation from case law implying that hindsight may be allowable so long it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. However, from the Examiner's argumentation, it is clear that the *only* indication to combine Takeuchi with Beshai is found in the arrangement of the present invention, and that the Examiner is using knowledge which was *not* available to the skilled person at the time the invention was made.

The Examiner is referred once again to the case law outlined in the Preliminary Amendment of March 6, 1995. This case law showing that the mere fact that a reference cited by an Examiner may be modified does not allow an Examiner to meet his burden for showing obviousness absent a suggestion in the cited art of the desirability of the modification. None of the cited references makes such a suggestion relative to the claims now presented. Moreover, it has been held that an Examiner "may not use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious".

Reconsideration and withdrawal of the outstanding rejection are respectfully requested.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C.
Attorneys for Applicant(s)
489 Fifth Avenue
New York, New York 10017-6105
Tel: (212) 697-3750
Fax: (212) 949-1690



Alan Israel
Registration No. 27,564